

**REMARKS**

Claim 24 is canceled without prejudice, and therefore claims 12 to 23 are now pending in the present application.

*Claim 19 is addressed herein as an independent claim, as suggested in the Notice of August 6, 200.*

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration of the present application is respectfully requested.

Applicants thank the Examiner for considering the Information Disclosure Statement, PTO-1449 paper, and cited references.

Applicants thank the Examiner for indicating that claim 24 contains allowable subject matter. While the rejections of the claims may not be agreed with, to facilitate matters, claim 12 (and claims 18 and 19) has been rewritten to include the features of claim 24, which has been canceled without prejudice. Accordingly, claim 12 is allowable, as are its dependent claims 13 to 17 (as is rewritten claim 18, as well as rewritten claim 19 and its dependent claims 20 to 23). It is therefore respectfully requested that the objection to claim 24 be withdrawn.

Claims 12 to 21 were rejected under 35 U.S.C. § 102(e) as anticipated by Barman et al., Published U.S. Patent Application No. 2002/0167726.

Claims 12 to 20 were rejected under 35 U.S.C. § 102(b) as anticipated by Stiller, German patent document no. DE 19962997.

To reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on

inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

*While the rejections of the claims may not be agreed with, to facilitate matters, claims 12, 18 and 19 have been rewritten to include the features of claim 24, which has been canceled without prejudice. Accordingly, claims 12, 18 and 19 are allowable, as are their respective dependent claims 13 to 17 and 20 to 23. Claim 21 has been rewritten to better conform it to its base claim 19, which has been rewritten. It is therefore respectfully requested that the rejections of the claims be withdrawn.*

Claims 19, 22 and 23 were rejected under 35 U.S.C. § 103(a) as unpatentable over Schirmer et al., U.S. Patent No. 6,363,619, in view of the “Stiller” reference or Lutter et al., U.S. Patent No. 6,771,208 or Sugimoto, U.S. Patent No. 6,061,015.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaack*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of

obviousness." *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

*While the rejections of the claims may not be agreed with, to facilitate matters, claims 12, 18 and 19 have been rewritten to include the features of claim 24, which has been canceled without prejudice. Accordingly, claims 12, 18 and 19 are allowable, as are their respective dependent claims 13 to 17 and 20 to 23. It is therefore respectfully requested that the rejections of the claims be withdrawn.*

Accordingly, all of pending claims 12 to 23 are allowable.

**Conclusion**

In view of the foregoing, it is respectfully submitted that all of claims 12 to 23 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

Dated: 9/8/2008

By: 

Gerard A. Messina  
(Reg. No. 35,952)

KENYON & KENYON LLP  
One Broadway  
New York, New York 10004  
(212) 425-7200

CUSTOMER NO. 26646

Reg. No. 35,952  
Aaron C. DEDITCH